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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/303,368	04/30/1999	MARION SCOTT BRIGHT	BU9-99-021	8261

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EXAMINER

O'CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/303,368	Applicant(s) Bright et al.	
	Examiner O'Connor	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 25, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 6, 8, 9, 11, 13-15, and 25-31 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6, 8, 9, 11, 13-15, and 25-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the amendment and arguments filed by applicant on April 13, 2005 in reply to the previous Office action on the merits, mailed January 13, 2005, and to the election and amendment filed by applicant on July 25, 2005 in reply to the Office action setting forth a requirement for restriction, mailed June 24, 2005.
2. The amendment of claims 1, 16, 21, 25, and 27 in the reply filed by applicant on April 13, 2005 is hereby acknowledged.
3. The cancellation of claims 16-24 in the reply filed by applicant on July 25, 2005 is hereby acknowledged.

Election/Restriction

4. Applicant's election without traverse of the invention of Group I, claims 1, 3, 4, 6, 8, 9, 11, 13-15, and 25-31, in the reply filed July 25, 2005 is hereby acknowledged.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 4, 6, 8, 9, 11, 13-15, and 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US 6,023,683).

Johnson et al. clearly anticipates all of the substantive elements of the instant invention, except that the system of Johnson et al. is an integrated, unitary system, performing all necessary processing steps/functions, whereas the system contemplated by the instant invention, while performing exactly the same steps/functions overall, merely splits the various processing steps/functions out into two separate processing systems, a “pre-processor” and a “processor.”

Thus, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Johnson et al., so as to split the processing steps/functions out into two separate modules or processing systems, a “pre-processor” and a “processor,” in order to improve overall system performance/throughput, since it is well settled that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Regarding claim 31, Johnson et al. do not specifically teach splitting the electronic sales order into at least two separate requests prior to transmitting to the order processing system. However, splitting an electronic order into two separate requests is certainly a well known, hence obvious, step to follow on processing an electronic order. For example, when an electronic order is placed for two different items, one of which is in stock and one of which is not in stock, the electronic order is typically split into two requests, one for immediate fulfillment and one as a backorder for later fulfillment when the unavailable item later becomes available, the credit card of the customer being charged two times, one time for the first request (first half of the split order) at the time of fulfillment of the first request, then later for the second request (second half of the split order) at the later time of fulfillment of the second request.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Johnson et al. so as to split the electronic sales order into at least two separate requests prior to transmitting to the order processing system, as is well known to do, in order to allow items in stock to be fulfilled immediately and the credit card of the customer charged immediately for those items being fulfilled immediately, and to allow the items not in stock to be backordered for later fulfillment when the unavailable items become available, with the credit card of the customer then being charged at that later time for those items being later fulfilled, so as to expedite sales of available items while maintaining customer satisfaction by not charging the customer in advance for unavailable items, since so-doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Response to Arguments

7. Applicant's arguments filed April 13, 2005 have been fully considered but they are not persuasive.

8. Regarding the argument that the system of Johnson et al. fails to perform error checking and correcting, the system of Johnson et al. indeed performs error checking and correcting. See, in particular, column 15, lines 10-19.

9. Regarding the argument that the system of Johnson et al. fails to include any human interaction other than by the user, the system of Johnson et al. indeed includes human interaction by the user and by the customer service representative that operates the workbench console to make corrections/changes as needed to the orders being prepared for processing.

10. Regarding the argument that splitting the order into two separate requests/orders prior to transmitting the order to the order processing system is not well known, such functionality is indeed well known, and, in any event, the system of Johnson et al. performs such functionality, splitting the order into two separate requests/orders prior to transmitting the order to the order processing system. See, in particular, column 15, lines 52-54, and column 17, lines 44-47.

11. Regarding the argument that no proper interpretation of Johnson discloses or suggests an order interceptor that is capable of adding, changing, or deleting electronic sales order data, wherein changes to an electronic sales order are logged, Johnson et al. indeed disclose or suggest an order interceptor that is capable of adding, changing, or deleting electronic sales order data, wherein changes to an electronic sales order are logged. See, in particular, column 15, lines 60-62).

12. In response to applicant's argument that the references applied in the rejection fail to use the same names for certain elements as the names used by applicant (i.e. "pre-processing" and "processing" versus "processing"), the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the identical words as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

13. For further detailed rebuttal and discussion of applicant's arguments, attention is directed to the Examiner's Answer and to the Decision on Appeal, both incorporated herein by reference.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to the disclosure.

15. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

October 17, 2005

A handwritten signature in black ink, appearing to read "Gerald J. O'Connor", followed by the date "10/17/05" written in a similar cursive style.

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627